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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/263,689	03/05/99	NI	J 1488.0560002

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EXAMINER

SUN HOFFMAN, L

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/263,689

Applicant(s)

NI et al

Examiner
Lin Sun-Hoffman

Group Art Unit
1642



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 17-89 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 17-89 _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 17-23, 28-34, 37-43, 46-51, 54-59, drawn to a polypeptide of SEQ ID NO:4, classified in class 530, subclass 326, 324, 350.
 - II. Claims 24, 35, 44, 52 and 60, drawn to an antibody against polypeptide SEQ ID NO:4, classified in class 530, subclass 387.1.
 - III. Claims 25, 36, 45, 53, 61, drawn to a method of detecting polypeptide SEQ ID NO:4, classified in class 435, subclass 7.1.
 - IV. Claims 26-27, drawn to a method of treatment by Galectin 9 (SEQ ID NO:4), classified in class 514, subclass 2.
 - V. Claims 62-67, drawn to an isolated protein comprising amino acid residues encodes by a first polynucleotide which hybridizes to a second polynucleotide having the nucleotide sequence of the coding region of SEQ ID NO:3, classified in class 530, subclass 350.
 - VI. Claim 68, drawn to an antibody against the protein of group V, classified in class 530, subclass 387.1.
 - VII. Claim 69, drawn to a method of detecting the protein of Group V, classified in class 435, subclass 7.1.
 - VIII. Claims 70-76, 81-87, drawn to a polypeptide of SEQ ID NO:8, classified in class 530, subclass 350.

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- IX. Claims 77 and 88, drawn to an antibody against SEQ ID NO:8, classified in class 530, subclass 387.1.
- X. Claims 78 and 89, drawn to a method for detecting Galectin 10, classified in class 435, subclass 7.1.
- XI. Claims 79-80, drawn to a method of treating a disorder with Galectin, classified in class 514, subclass 2.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I, II, V, VI, VIII, IX are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups III, IV, VII, X and XI differ in the method objectives, method steps and parameters and in the reagents used.

Inventions I and IV, II and III, VI and VII, VIII and XI, IX and XI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Groups I, VIII can also be used as an immunogen in methods of generating antibodies. The antibodies of Group II, VI and IX can be used for purification schemes.

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3. Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Sun-Hoffman, whose telephone number is (703) 308-7552.

Lin Sun-Hoffman, Ph.D.

June 16, 2000

A handwritten signature in black ink, appearing to read 'Nancy A. Johnson', with a long horizontal flourish extending to the right.

NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER